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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/609,622 07/05/00 SUNVOLD

G IAM 0602 PA

EXAMINER

HM12/0711

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COE, S

ART UNIT

PAPER NUMBER

1651

DATE MAILED:

07/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

**Office Action Summary**

Application No.

09/609,622

Applicant(s)

SUNVOLD ET AL.

Examiner

Susan Coe

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 23 April 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8,9 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other:  |

### **DETAILED ACTION**

1. The amendment filed April 23, 2001, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.
2. Claims 2, 6, and 7 have been cancelled.
3. Claim 14 has been added.
4. Claims 1, 3-5, and 8-14 are pending.

### ***Election/Restrictions***

5. Applicant's election with traverse of Group I, claims 1-9 and 14 in Paper No. 6, dated April 23, 2001, is acknowledged. The traversal is on the ground(s) that a search of both groups would not be burdensome because both groups are classified in the same class and subclass. This is not found persuasive because while the patent classification search might overlap, the search would not be coextensive with regard to the literature search that is required for a thorough search of the case. Therefore, a search of the entire case would place a burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

6. Claims 10-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 6.

7. Claims 1, 3-5, 8, 9, and 14 are examined on the merits.

***Claim Rejections - 35 USC § 102***

8. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,104,677 for the reasons set forth on pages 4 and 5 of the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the composition of L-carnitine, chromium, Vitamin A, and low glycemic index grain taught by US '677 would not inherently have the effect of promoting weight loss because the composition of US '677 has a high calorie content. However, the composition taught by US '677 is the same as applicant's composition. Specifically, US '677 teaches a composition that comprises L-carnitine, chromium, Vitamin A, and low glycemic index grain. This composition is identical to the composition that is claimed by applicant. Therefore, if applicant's composition functions as claimed, the composition of US '677 would inherently function in the same manner due to the fact that both compositions are the same.

***Claim Rejections - 35 USC § 103***

9. Claims 1, 3-5, 8, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,626,849, the Purina CNM Veterinary Product Guide (published in 1994 by the Ralston Purina Company), and US Pat. No. 5,240,962 for the reasons set forth on pages 5-7 of the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the references do not provide motivation to combine the specific ingredients in one weight loss composition. However, the

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Purina Product Guide clearly teaches a dry food that contains corn and Vitamin A. The purpose of this food is to lower weight. Secondly, US '962 teaches that corn, sorghum, wheat, and barley can be used interchangeably as a carbohydrate source in weight loss compositions. Finally, US '849 teaches that chromium and L-carnitine are also useful in weight loss compositions. Based on these teachings, a person of ordinary skill in the art would have had a reasonable expectation that sorghum, wheat, and barley could be used as the carbohydrate source in the weight loss food taught by the Purina Product Guide and that chromium and L-carnitine could be added to this composition based on the disclosure by US '849 that these ingredients lower weight. Therefore, since all of the ingredients were known in the art at the time of the invention to be useful in weight loss compositions, a person of ordinary skill in the art would have been motivated to combine the ingredients in a single composition.

Applicants also argue that US '962 does not teach using low glycemic grains to lower weight. However, US '962 clearly states that corn, sorghum, wheat, and barley are suitable carbohydrate sources to use in weight loss compositions. Therefore, a person of ordinary skill in the art would recognize that these would be beneficial to use in weight loss compositions. Therefore, using these carbohydrates in a weight loss composition flows from the teaching of the prior art. Simply because applicant has a different reason for adding the carbohydrates cannot be the basis for patentability.

10. No claims are allowed.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 7:30 to 5:00 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SDC  
July 9, 2001



FRANCISCO PRATS  
PRIMARY EXAMINER